

### Remarks

Claims 1-7, 12, 16-18, 23, 27-29, 34, and 38-40 are pending in this application. Pursuant to restriction requirement, claims 8-11, 13-15, 19-22, 25-26, 30-33, and 35-37 are canceled without prejudice. Claims 1-5 and 7 are also amended pursuant to restriction requirement. Applicants reserve their rights to pursue the subject matter deleted from this application in one or more divisional, continuation, or continuation-in-part applications. The pending claims are also amended for formal reasons. No new matter has been added. Applicants respectfully submit that the rejection of pending claims should be withdrawn for at least the following reasons.

### Objection to Claims for Informalities Should Be Withdrawn

On page 5 of the Office Action, claim 1 is objected to because the nitrogen of the cyano group is missing from the depicted formula (I). In view of the amendment introduced to claim 1, this objection should be withdrawn.

Claims 1-5, 7, 12, 16-18, 23, and 27-29<sup>1</sup> are also objected to as allegedly containing non-elected subject matter. In view of the claim amendments introduced herein, Applicants respectfully request that the objection to these claims be also withdrawn.

### The Rejection Under 35 U.S.C. § 102 Should Be Withdrawn

On pages 5-6 of the Office Action, claims 1-4, 18, and 29 are rejected as allegedly anticipated by Groundwater *et al.*, *Tetrahedron*, 48(37): 7951-7964 (1992) ("Groundwater"). In particular, it is alleged that Groundwater discloses 3,3-bis-(3-methoxyphenyl)-2-propenenitrile, which is allegedly encompassed by claim 1. Applicants respectfully traverse this rejection.

In the Office Action, it is alleged that 3,3-bis-(3-methoxyphenyl)-2-propenenitrile corresponds to a compound of claim 1, "wherein R<sub>2</sub> is a lower alkyl (specifically a methoxy), wherein R<sub>1</sub> is an alkyl (specifically a methyl), X is -O- and R<sub>3</sub> is phenyl substituted with an alkoxy (specifically 3-methoxyphenyl)." Office Action, page 5. This is incorrect. Instead, the compound could only fall within the scope of claim 1 if R<sup>2</sup> is H, R<sup>1</sup> is methyl, and R<sup>3</sup> is methoxyphenyl. However, the pending claim 1 does not encompass compounds wherein R<sup>2</sup> is a hydrogen. Therefore, Applicants respectfully request that the rejection of claims 1-4, 18, and 29 under 35 U.S.C. § 102 be withdrawn.

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<sup>1</sup> Although claim 34 is also cited, Applicants respectfully point out that claim 34 depends from claim 6, and thus should not have been objected to.

The Rejection Under Judicially Created Obviousness-Type Double Patenting

On pages 6-15 of the Office Action, various pending claims are rejected under the judicially-created doctrine of obviousness-type double patenting. In particular, three separate rejections are raised in the Office Action: 1) claims 1-5, 7, 18, and 29 are rejected over claim 6 of U.S. Patent No. 5,929,117 ("the '117 patent"); 2) claims 1-7, 16-18, 27-29, and 38-40 are rejected over claims 1-2, 6, and 11 of the '117 patent; and claims 12, 23, and 34 are rejected over claim 5 of the '117 patent. Without addressing the substance of the rejection, Applicants respectfully request that the rejection be held in abeyance until the claims are deemed otherwise allowable. Applicants will file a terminal disclaimer, if necessary, at such time.

No fee is believed due for this submission. However, if any fees are required for the entry of this paper or to avoid abandonment of this application, please charge the required fees to Jones Day Deposit Account No. 503013.

Date: February 10, 2005

Respectfully submitted,

  
Max Bachrach 45,479  
(Reg. No.)

**Jones Day**  
51 Louisiana Avenue, N.W.  
Washington, D.C. 20001-2113  
(202) 879-3939

For: Anthony M. Insogna (Reg. No. 35,203)  
**Jones Day**  
12750 High Bluff Drive, Suite 300  
San Diego, California 92130  
(858) 314-1200